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D-1120 R2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
Drummond, et al.)	
)	Art Unit 3693
Application No.: 09/811,718)	
)	
Appeal No.: 2010-010105)	Patent Examiner
)	Daniel Felten
Filed: March 19, 2001)	
)	
Title: Method And System For)	Confirmation No.: 2928
Connecting Services To An)	
Automated Transaction Machine)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS

Sir:

The Appellants hereby submit their Reply Brief in response to the Examiner's Answer
dated July 9, 2010.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

STATUS OF CLAIMS

Claims 25 and 44-119 are pending in the Application.

Claims rejected: 25 and 44-119

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: 1-24 and 26-43

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

Whether claims 25 and 44-119 are unpatentable pursuant to 35 U.S.C. § 103(a) over Zeanah (US 5,933,816) in view of Gutman (US 5,221,838).

ARGUMENT

Appellants' Reply to the "Grounds of Rejection" section of the Answer

As best understood, the rejections set forth in the Answer (at pages 3-4) appear to correspond to the grounds previously presented in the Office Action dated January 13, 2003, from which appeal was initially taken. Thus, Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in their Appeal Brief filed on March 19, 2004. Therefore, please note Appellants' previous arguments (in their Appeal Brief) regarding all the issues of record.

Appellants' Reply to the "Response to Argument" Section of the Answer

The Answer includes a "Response to Argument" section beginning on page 4. However, this section provides no new support for the rejections. Furthermore, this section only addresses a portion of Appellants' many arguments made in the Appeal Brief in support of allowance.

As best understood, this "Response to Argument" section only addresses claim 25, and then only the step (a) feature of claim 25. For example, the Answer (on page 4) states that "Appellant asserts on page 11 of the Brief that there is no suggestion of connecting a transaction service in a host automated machine, where the transaction service includes a transaction function device and the host automated transaction machine includes a lookup service." In response, the Answer (on page 4) contends that Zeanah teaches an external service provider interface that provides a service proxy. However, Zeanah does not mention nor discuss any service proxy.

Furthermore, the Answer ignores the many features and relationships of claim 25. Nor does the Answer consider claim 25 as a whole, but rather in a vacuum. An exemplary embodiment of claim 25 enables a transaction service (cash dispensing) to be registered with a lookup service of a host ATM, which registering includes storing a copy of a service proxy in association with the lookup service. This enables a service proxy copy to be wirelessly acquired from the host ATM by a portable personal device (e.g., a cell phone) which is "configured to run a personal ATM service application that performs banking operations as is done at non-portable ATM workstations" (e.g., Appellants' specification page 31, lines 1-10).

The cell phone can then use the acquired service proxy to operate the host ATM to dispense cash. That is, an exemplary method of claim 25 enables a cell phone user to download a copy of a service proxy (e.g., a Java® object) from a cash dispensing ATM to the cell phone, which in turn allows the cell phone user to operate the cash dispensing ATM to dispense cash (via the cell phone's user interface instead of the cash dispensing ATM's user interface).

The recited invention was not considered as a whole

Clearly the rejections are based on individual pieces of recited subject matter taken separately for review, and not on the entire recited subject matter taken as a whole. As the Examiner failed to consider the recited invention as a *whole*, the rejections are legally improper.

The applicable legal standard for "obviousness" has not been met by the Office

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections are legally improper because the required legal criteria for establishing "obviousness" has not been met by the Office. "The Examiner has the initial burden to set forth the basis for any rejection so as to put the patent applicant on notice of the reasons why the applicant is not entitled to a patent on the claim scope

that he seeks -- the so called '*prima facie* case.'" *Ex parte Frye*, (Bd. Pat. App. & Inter. 2/26/2010, Appeal No. 2009-006013). That is, in order to present a legally valid rejection based on obviousness, it is necessary for the Examiner to make a *prima facie* showing of obviousness.

Prima facie obviousness requires a showing that *each* of the recited features and relationships was known in the prior art. As discussed above, there is no showing in the record that each of the recited features and relationships was known in the prior art. If the Office fails to establish a *prima facie* case of obviousness (which is the current situation), then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142).

Even in cases where the Office has made a *prima facie* showing of obviousness (which is not the current situation), a rejection cannot be properly made unless there is a requisite showing that it would have been obvious to one having ordinary skill in the art at the time the invention was made, to have combined features and relationships to have produced (at that time) the invention as claimed. It is not proper to reject a claim on the basis of obviousness unless there is an identified valid reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), 82 USPQ2d 1385 (2007).

In accordance with the dictates of the United States Supreme Court in *KSR International Co.*, supra, the determination as to whether there is a reason to combine prior art features must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,

- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

The Action fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination and resolve the level of ordinary skill in the pertinent art which existed at the time Appellants' invention was made. MPEP § 2141(2)(C). It is respectfully submitted that the Action from which this appeal has been taken does not include such a full determination. That is, there is no evidence of record that the level of one of ordinary skill in the art at the time of Appellants' invention has been resolved by the Office. Nor has the record established the Examiner to be a person of ordinary skill in the art at the time of Appellants' invention.

The rejections are further legally improper because "[Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

The rejections are *not* based on one of ordinary skill in the art at the time of the present invention

The 35 U.S.C. § 103(a) rejections are also faulty because they do not correctly apply the level of ordinary skill in the art at the *time of the present invention*. Appellants respectfully submit that the Office did not reach a conclusion based on facts gleaned only from the prior art at the time of the invention. Rather, the Office improperly attempts to apply a "2010" level of ordinary skill in the art.

The record shows that the reasons for reference modification in the rejections are based on the mere opinion of the Examiner. Thus, it must be concluded that the basis for reference modifying in the rejections is *not* based on the opinion of a person of ordinary skill in the art at the time of the present invention. That is, the alleged reasons for reference modifying are at best based on the opinion of the Examiner, which opinion is entitled no evidentiary weight because (as previously discussed) the Examiner has *not* been established in the record as a person of ordinary skill in the art at the time of the present invention. For this additional reason, the rejections are legally improper and should be withdrawn.

The rejections are based on attempted impermissible hindsight reconstruction

At best, the rejections are based on attempted hindsight reconstruction of the claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. The Office has not established a *prima facie* case of obviousness. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art at the time of the invention to have produced the recited invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections should be reversed.

Additional Comments

The disclosure of Zeanah is incomprehensible due to lack of details concerning operation of the system. Zeanah does not contain sufficient information to enable one of ordinary skill in the art to make or use an operable system without undue experimentation. Due to Zeanah's confusing and inconsistent description, and lack of disclosure on how the system could be made to operate, Appellants have been required to speculate as to how the Zeanah system could be made to operate. Therefore, any comments during appeal related to Zeanah shall not be

construed as agreement or an admission by Appellants that the Zeanah system is capable of operation or of achieving any of the functions carried out by Appellants' system. Rather, the person of ordinary skill in the art would consider Zeanah to be inoperative and non-enabling with respect to the recited subject matter.

Likewise, a combination of Zeanah and Gutman would not enable a person of ordinary skill in the art to produce the recited invention. A combined Zeanah and Gutman does not provide an enabling disclosure which would enable a person of ordinary skill in the art to produce the recited invention.

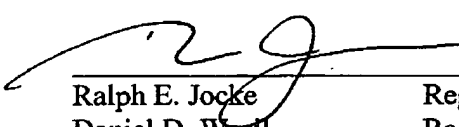
CONCLUSION

For sake of brevity and to avoid further repetition of the Appeal Brief, attention is again directed thereto for additional reasons as to why the references do not render obvious the appealed claims. More detailed remarks regarding all the issues of record, including support for the patentability of each claim, can be found in the Appeal Brief.

It is respectfully requested that the Board review the particular findings contested by the Appellants "anew in light of all the evidence and arguments on that issue." *Ex parte Frye*, supra. That is, the Appellants respectfully request the Board to review whether the Examiner met the *Office's burden* of establishing a legally valid rejection, not whether the Appellants met some burden of proving error in the Examiner's actions.

The Appellants respectfully submit that each of their pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, motivation, or valid reason for combining features thereof to produce the recited invention. For these reasons it is respectfully submitted that all pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
Daniel D. Wasil
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029
Reg. No. 45,303